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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,755	10/24/2003	Mark Albert Feucht	07650.00103	2436
62507 7590 12/29/2006 TURNER PADGET GRAHAM & LANEY, P.A. P.O. BOX 1509 GREENVILLE, SC 29602			EXAMINER YIP, WINNIE S	
			ART UNIT	PAPER NUMBER
			3636	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/693,755	Applicant(s) FEUCHT ET AL.	
	Examiner Winnie Yip	Art Unit 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 18-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's amendment filed on October 4, 2006.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response To Election/Restrictions

1. Applicant's election with traverse of election of species in the reply filed on April 10, 2006 is acknowledged. The traversal is on the ground(s) that all claims should be considered simultaneously since the searching and prosecution would be expedited to do so. And, examiner does not provide a clear and detailed reason of making a restriction and examiner does not provide groups of claims for different inventions. This is not found persuasive because, first, this application is restricted to contain patentably distinct species as shown in Figures 2, 4, 6, 8, 12, and 15 but does not restricted under different inventions (not a combination and sub-combination restriction). These species show various mounting brackets require different structural limitations that are considered patentably distinct. For example, Figure 2 shows specie of a mounting bracket with an inclined portion; Figure 4 shows specie of a mounting bracket with a bushing element; and Figure 10 shows specie of a mounting bracket with alignment means. The claimed invention does not necessary include "alignment means" as shown in the embodiment of Figs. 12. On the other hand, the claimed feature of "alignment means" does not read on the embodiments, Figs. 2, 4, 6, 8, and 10. These various mounting brackets require Text search in different terms. Therefore, it is application's responsibility to reply the restriction requirement including an identification of single disclosed specie that is elected and a listing of all claims readable thereon. Since applicant did not distinctly an specifically point out that the species are

clearly obvious over each other, the restriction requirement of species is still deemed proper, and the requirement is therefore made FINAL.

2. Applicant's election of species in the reply filed on April 10, 2006 is acknowledged. Because applicant did not elect a single disclosed specie in the reply, examiner held a telephone conversation with Mr. Clair on December 19, 2006, applicant elected a specie as shown in Figure 12. However, applicant stand to elect processing claims 9-17 that is readable on Fig. 17 with no specie of "a mounting bracket" is claimed. A provisional election was made to proceed with claims 9-17 without prejudice (see the reply filed April 10, 2006). Claims 1-8 and 18-39 are withdrawn from further consideration.

The restriction requirement is made Final.

Claim Rejections - 35 USC § 102

3. Claims 9-10, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent No. 9-67909 to Tanaka et al.

Tanaka et al. show and disclose a skylight with flashing profile for installation on a roof, comprising: a skylight frame (1 or 101) having a top element, a bottom element and two side elements connected together to define a rectangular shaped interior opening therein (see Fig. 8), the frame (1 or 101) being mounted to a roof surface (7) by a plurality of L-shaped mounting brackets (6), a flashing profile (5 or 105) including a rigid section having a first flashing leg (5) and a second flashing leg (4), the first flashing leg (5) being attached to one of the side element of the frame (1), the second flashing leg (4) connecting the frame to the roof surface (7), and a flexible section (8) being attached to the second flashing leg (4) by adhesive, and a rigid flashing

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profile (104) connected to one of top and bottom elements of the frame respectively, wherein the flashing profile (1) and the rigid flashing profile (104) extend along the longitudinal lengths of two different elements of the frame, the rigid section of the flashing profile (5) and the rigid flashing profile (13 or 14) made of extruded metal or rigid plastic, and the flexible section (8) is made of water proof sheet.

Regard to claim 10, Tanaka et al. teach a skylight with a flashing profile, wherein the rigid section of the flashing profile having the second flashing leg (4) having a flat portion attached to the roof surfaced (7) and a raised folded portion extending upward (see Fig. 2) form the flat portion such that the raised folded portion, the flat portion of the second flashing leg, and a first flashing leg defined a channel for drainage of water (see Fig. 2).

4. Claims 9, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by the US Patent No. 4,848,051 to Weisner et al.

Weisner shows and discloses a skylight with flashing profile for installation on a roof, comprising: a skylight frame (26) having a top element, a bottom element and two side elements connected together to define a rectangular shaped interior opening therein, the frame (26) being mounted to a roof surface (30) by a plurality of mounting brackets (40), a flashing profile including a rigid section (16) having a first flashing leg (19) and a second flashing leg (17), the first flashing leg (19) having a projected web portion (20) carried by and connected to one of the side element of the frame (26) by the fasteners (23), the second flashing leg (17) having a vertical raised portion (17) for mounting the frame to the roof surface (30) by the mounting brackets (40), the flashing profile also including a flexible section (46) being attached to the

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second flashing leg (17) by adhesive (34) and crimping, and a rigid flashing profile (13 or 14) connected to each of top and bottom elements of the frame respectively, wherein the flashing profile (16) and the rigid flashing profile (13, 14) extend along the longitudinal lengths of two different elements of the frame, the rigid section of the flashing profile (16) and the rigid flashing profile (13 or 14) made of extruded aluminum or rigid plastic, the flexible section (46) is made of synthetic polymeric material such as resilient plastic (see col. 5, lines 25).

5. Claims 9-14, and 17 are alternatively rejected under 35 U.S.C. 102(b) as being anticipated by the US Patent No. 4,848,051 to Weisner et al.

Weisner is considered to show and disclose a skylight with flashing profile for installation on a roof, comprising: a skylight frame (26) having a top element, a bottom element and two side elements connected together to define a rectangular shaped interior opening therein, the frame (26) being mounted to a roof surface (30) by a plurality of mounting brackets (40), a flashing profile including a rigid section (16) having a first flashing leg (19) and a second flashing leg (17), the first flashing leg (19) having a projected web portion (20) carried by and connected to one of the side element of the frame (26) by the fasteners (23), the second flashing leg (17) mounted to the plurality of mounting brackets for mounting the frame to the roof surface (30), the flashing profile also including a flexible section (44) being attached to the second flashing leg (17) by adhesive (34) and crimping, and a rigid flashing profile (13 or 14) connected to each of top and bottom elements of the frame respectively, wherein the flashing profile (16) and the rigid flashing profile (13, 14) extend along the longitudinal lengths of two different elements of the frame, the rigid section of the flashing profile (16) and the rigid flashing profile

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(13 or 14) made of extruded aluminum or rigid plastic, the flexible section (44) made of sheet of elastic material.

In regard to claims 10-14, Lindgren discloses a skylight with flashing profile, wherein the second flashing leg (17) has a raised folded portion (46), the raised folded portion (46) is turned down such that an upper end of the raised folded portion is substantially perpendicular with the first flashing leg (19), the flexible section (44) having an end of a vertical portion (44B) being attached to the raised folded portion by adhesion with adhesive (34) and crimping, and having another end of a flat portion (44C) extending outward therefrom.

Claim Rejections - 35 USC § 103

6. Claims 9-10, 12, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 19734346 in view of European Patent No. 0148,429 to Handel.

German Patent '346 show and disclose a skylight with flashing profile for installation on a roof, comprising: a skylight frame having a rectangular profile including a top element (19d), a bottom element (19a), and two side elements (19b, 19c) being connected together to define a rectangular shaped profile with a rectangular-shaped interior opening (15d) therein, the frame being mounted on the roof support by a plurality of mounting brackets (see Figs. 1 and 4), a flashing profile including a rigid section (9) having a first flashing leg (13) and a second flashing leg (9b or 9c), the first flashing leg (13) being attached to one of the side element of the frame, the second flashing leg (9b, 9c) connecting the frame to the roof surface, the second flashing leg (9b, 9c) having at least one raised folded portion (29), wherein the raised folded portion (29) has an end (the outer end of the second flashing leg) being turned down and extending outwardly such that the end of the raised folded portion is substantially perpendicular to the first flashing

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leg, and a rigid flashing profile (15a) being connected to one of top and bottom elements of the frame respectively, wherein the flashing profile (9) and the rigid flashing profile (15a) extend along the longitudinal lengths of two different elements of the frame, the rigid section of the flashing profile (9b or 9c) and the rigid flashing profile (15a) made of extruded metal sheet.

Although German Patent does not define the flashing profile having a flexible section attached to the second flashing leg of the rigid section as claimed invention, Handel teaches a skylight with flashing profile for installation on a roof, comprising a frame (10) and a flashing profile (8) having a rigid section having a first flashing leg (9) being attached to the frame, and a second flashing leg having at least one raised folded portion (11, 12) to define at least one channel (13 or 14) formed on the second flashing leg for drainage of water, and a flexible section (16) made of synthetic elastomeric material adhesively attached to the second flashing leg of the rigid section for sealing a roof member (17) mounted over the flashing profile (8). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the flashing profile of the German Patent having a flexible section attached to the second flashing leg of the rigid flashing section as taught by Handel for sealing a roof member such as tiles disposed over the skylight onto the roof via the flashing profile on roof surface.

Response to Arguments

7. Applicant's arguments filed October 4, 2006 with respect to the objection of claims 11 and 13 have been fully considered. The objection is withdrawn. The claims 11-13 have been treated on the merits as an apparatus claim only with the flexible section being attached to the raised folded portion. The method step of how to attach by "crimping", therefore, is given very little patentable weight.

8. Applicant's arguments filed October 4, 2006 with respect to the rejection of claims 9-17 under 35 U.S.C. 102/103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejections are set forth above.

Citations

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Japanese Patent No. 10-266484 to Osabe and European Patent No. 1,550,777 to Kristensen teach various skylights comprising a flashing profile including a rigid section having a first and second legs with a raised folded portion to defining a channel for the drainage of water as similar to the claimed invention. Wasserman '702 teaches a skylight structure having flashing profile including a rigid section and a flexible section as similar to the claimed invention. Sampson et al. '208, Raap et al. '396, and Borresen et al. '713 teach various skylight structures having a frame attached to the roof by mounting brackets and having a flashing profile as similar to the claimed invention.


Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Winnie Yip
Primary Examiner
Art Unit 3636

wsy
December 22, 2006